

In re Patent Application of

Atty SCS-124-1104  
Dkt.

C# M#

BARNES et al

TC/A.U. 2814

Serial No. 10/522,988

Examiner: A. Kalam

Filed: February 2, 2005

Date: June 14, 2007

Title: OPTOELECTRONIC DEVICES



IFW

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE/AMENDMENT/LETTER**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment 15 minus highest number  
previously paid for 20 (at least 20) = 0 x \$50.00 \$0.00 (1202)/\$0.00 (2202) \$

Independent claims after amendment 5 minus highest number  
previously paid for 5 (at least 3) = 0 x \$200.00 \$0.00 (1201)/\$0.00 (2201) \$

If proper multiple dependent claims now added for first time, (ignore improper); add  
\$360.00 (1203)/\$180.00 (2203) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s)  
One Month Extension \$120.00 (1251)/\$60.00 (2251)  
Two Month Extensions \$450.00 (1252)/\$225.00 (2252)  
Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)  
Four Month Extensions \$1590.00 (1254)/\$795.00 (2254)  
Five Month Extensions \$2160.00 (1255)/\$1080.00 (2255) \$

Terminal disclaimer enclosed, add \$130.00 (1814)/\$65.00 (2814) \$

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee \$180.00 (1806) \$ 0.00

Assignment Recording Fee \$40.00 (8021) \$ 0.00

Other: \$ 0.00

**TOTAL FEE \$ 0.00**☐ **CREDIT CARD PAYMENT FORM ATTACHED.**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.  
By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: 



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

BARNES et al

Atty. Ref.: 124-1104; Confirmation No. 4650

Appl. No. 10/522,988

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\* \* \* \* \*

June 14, 2007

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Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

This is responsive to the Restriction Requirement mailed May 15, 2007 (Paper No. 20070510), the date of response to which is June 15, 2007.

**1. Restriction Practice under 35 USC §121 is improper for this application**

Applicants note that the Examiner is improperly requiring election under 35 USC §121 in this application which is national stage entry of International Application No. PCT/GB03/03343. The Manual of Patent Examining Procedures (MPEP) at §1895.01, deals specifically with the handling of national stage entry applications under 35 USC §371 and states that “restriction practice under 35 USC §121, as it applies to national applications submitted under 35 USC 111(a) is **not applicable to either international or national stage applications.**” (emphasis added). Thus, the Examiner’s application of 35 USC §121 is not applicable to this national stage

entry of a PCT International application and therefore any further application of §121 or PTO procedures under §121 is respectfully traversed.

The Examiner's attention is also directed to the MPEP Section 1893.03(d) entitled "Unity of Invention." In that portion of the MPEP, it is stated that "examiners are reminded that unity of invention (not restriction) practice is applicable in International applications (both Chapter I and II) and in national stage applications." It is noted that unity of invention requirements of the PCT prevent any restriction practice as to separate species and thus the Examiner may not implement any restriction under 35 USC §121.

**2. If restriction is proper under 35 USC §121, then it should be between only two species**

Restriction is required among Species I, II, III and IV shown in Figures 4(a), (b), (c) and (d). Applicants note that the Examiner admits that claim 14 is generic to all of the above-noted species and this acknowledgment is very much appreciated.

It is also noted that claim 1 is believed to be generic to three identified species, i.e., Species I-III. Applicants believe that, at best, there are only two distinct species in the present invention – one species having grating formed at at least one metal electrode surface (Figures 4(a), 4(b), 4(c)) and the other in which the metal electrode is planar and the grating is formed in a further dielectric layer (Figure 4(d)). Thus, Applicants believe that there are only two distinct species and that claims 1 and 14 are generic to the three figures, Figure 4(a)-4(c) directed to gratings formed at at least one metal electrode surface.

In this regard, should the Examiner dispute that restriction practice under 25 USC §121 is not permitted and agree that there are only two groups of species, applicant elects, with traverse,

the species of Figures 4a-4c with claims 1 and 14 being generic and claims 1-4 and 6-15 are readable thereon.

**3. Election of Examiner's Species with strong traverse**

Notwithstanding the above traversal of any restriction under 35 USC §121 and the above discussion of an alternative restriction, should the Examiner conclude that, in some fashion 35 USC §121 is applicable to this national stage PCT application (and this applicability is strenuously traversed), Applicants, in response only to the requirement of the Official Action, identifies Species I of Figure 4(a) and claims 1, 2, 4, 6-10, 11, 14 and 15 readable thereon. However, this restriction requirement is strenuously traversed and has no basis in statute or PCT practice rules.

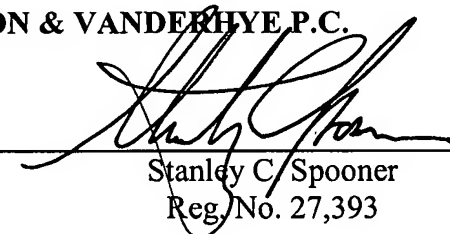
Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that the restriction requirement is improper and specific consideration of the impropriety of this requirement by the Examiner Abul Kalam, his supervisor Wael Fahmy and the supervisory primary examiner Phat Cao is respectfully requested. In the event the Examiners are of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the claims, they are respectfully requested to contact Applicants' undersigned representative.

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Respectfully submitted,

**NIXON & VANDERHYTE P.C.**

By: \_\_\_\_\_

  
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